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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,)
Plaintiff,)
vs.) No. 99cv2668 H (AJB)
VYSIS, INC.,)
Defendant.)

The confidential deposition of DONALD
NEIL HALBERT, Ph.D., called as a witness for
examination, taken pursuant to the Federal Rules of
Civil Procedure of the United States District
Courts pertaining to the taking of depositions,
taken before ANDREA L. CARTER, a Notary Public
within and for the County of Cook, State of
Illinois, and a Certified Shorthand Reporter of
said state, CSR No. 84-3722, at 100 Abbott Park
Road, Abbott, Illinois, on the 19th day of April,
A.D. 2001, at 10:17 a.m.

COPY

1 definition of amplify that we looked at in column 2
2 of the '338 patent?

3 A. I don't recall.

4 Q. Are you aware of anyone else at either
5 Gene-Trak or Amoco that during -- again bracketing
6 those two dates that did any work that you would
7 believe fell within the definition of amplify?

8 A. I really don't recall.

9 Q. During the discussions that took place
10 between you -- some combination of you,
11 Dr. Lawrie, Dr. King, Dr. Collins that we have
12 talked about earlier, were there proposals advanced
13 for methods to amplify nucleic acids that had been
14 captured using a capture probe?

15 A. I believe that's correct.

16 Q. What proposals were advanced?

17 A. I can recall nonspecific methods of
18 amplification as defined by random hexamer probe
19 amplification and other types of enzyme --
20 enzymatic amplification. Frankly, I am not sure
21 whether my recollection is accurate going back to
22 that date--or whether it's based on me going back
23 and reviewing some of the documents that I have
24 seen in the meantime.

1 Q. Including the invention disclosure?

2 A. Correct.

3 Q. Is it true that there was a general
4 desire -- again, I will use these same dates of
5 bracketing November 1985 and 1986 unless I indicate
6 otherwise. But during this time frame, that there
7 was a desire to identify amplification techniques
8 that could be used to amplify a nucleic acid that
9 did not involve PCR?

10 A. Yes.

11 Q. And is it true that the reason why there
12 was a desire to find something other than PCR is at
13 least in part that there were questions --
14 scientific, technical questions as to whether or
15 not PCR at that time could be adequately
16 quantitated for use in a diagnostic assay?

17 A. I seem to recall those types of
18 discussions, yes.

19 Q. And was there -- wasn't there also a
20 concern within the Amtrack -- Amtrack. It would
21 have been a great name if they combined the
22 companies between the Amoco and Gene-Trak.

23 MR. BANKS: I think that was taken.

24 BY MR. SWINTON:

Ex. 8 Pg. 75

1 Q. Between the Amoco and Gene-Trak teams,
2 wasn't there also a concern that helped to motivate
3 in part this desire to find something other than
4 PCR that there were concerns about whether or not
5 PCR was going to be available for other
6 participants in the industry to use other than the
7 then presumed owner of Cetus?

8 A. Yes.

9 MR. VESSELINOVITCH: Objection to the --
10 BY MR. SWINTON:

11 Q. Where there any other concerns expressed
12 among this assembled group during this time period
13 that motivated a desire to find an amplification
14 method other than PCR?

15 A. Could you repeat that question?

16 Q. Sure. Were there any other concerns
17 expressed among this assembled group during this
18 time frame that formed at least in part a
19 motivation to find an amplification method other
20 than PCR?

21 MR. BANKS: Object to form.

22 BY THE WITNESS: - - - - -

23 A. Not that I recall.

24 BY MR. SWINTON:

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